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the TTAB

Paper No. 29
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Girl Scouts of the United States of America
v.
Girlsports Brand, Inc.[1]

Opposition No. 91120051
to application Serial No. 75517912
filed on July 13, 1998

William R. Golden, Jr., Margaret Ferguson and Paul W. Garrity of Kelley Drye & Warren LLP for Girl Scouts of the United States of America.

Kathleen E. Finnerty of Livingston & Mattesich for Girlsports Brand, Inc.

Before Seeherman, Hairston and Rogers, Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Girlsports Brand, Inc. [applicant], by assignment from Girlsports Brand, seeks to register the mark shown below for goods identified as "clothing, namely T-shirts, shorts, sweatshirts, sweatpants and caps," in International Class

[1] USPTO assignment records, at Reel 2171, Frame 0248, indicate the involved application has been assigned from Girlsports Brands (a limited partnership) to Girlsports Brands, Inc.

25. The application was filed July 13, 1998 and is based on applicant's allegation of its intention to use the mark in commerce.[2]

Girl Scouts of the United States of America [opposer] has filed a notice of opposition. In its notice of opposition, opposer asserts that it "is now using and for many years past has used the mark GIRLSPORTS," "for and in connection with" programs that promote "social, physical and intellectual growth and development" of girls, as well as their "lifelong participation in health and fitness activities"; that it has prior use of the GIRLSPORTS mark in interstate commerce "for and in connection" with its programs and "related goods and services" "including but not limited to clothing"; that its use of the GIRLSPORTS mark has been continuous; that it has also adopted and used "GIRLSPORTS formative marks" such as GIRLSPORTS 1999, GIRLSPORTS 2000, GIRLSPORTS BASICS, GIRLSPORTS LEADERSHIP

[2] The application includes a disclaimer of the word BRAND. Though the application was never amended to assert that applicant had begun use of its mark in commerce, in its brief applicant asserts that it began use of the mark in commerce in November 1998 and has used it continuously since then. Brief, p. 30. The record confirms that applicant did, in fact, receive its first order in November 1998 and has continuously expanded its business since then.

INSTITUTE and GIRLSPORTS WIDER OPPORTUNITY; that because of "long and extensive use in commerce, the GIRLSPORTS mark … is well and favorably known and of great value" to opposer; that applicant's mark so closely resembles opposer's mark that there exists a likelihood of confusion, mistake or deception; and opposer asserts that it will be damaged by issuance of a registration to applicant.

In addition to this claim which, although opposer does not refer to the statute, is clearly based on Section 2(d) of the Trademark Act, opposer also asserts a claim under Section 36 of Title 36 of the United States Code [this section now appears to be 36 U.S.C. §80305]. Specifically, opposer asserts that 36 U.S.C. §36 grants it the "sole and exclusive right to have and to use" certain "emblems and badges, descriptive or designating marks, and words and phrases" both "for carrying out" its programs and furthering its purposes and also "in connection with the manufacturing, advertising, and selling of equipment and merchandise." While opposer does not state, in its pleading, that any particular "emblems and badges, descriptive or designating marks, and words and phrases" are reserved for opposer by this statute, it does assert that applicant's use of GIRLSPORTS BRAND is "in direct contravention and derogation" of the rights it has been granted by Congress.

Applicant, by its answer, admits that opposer is a federally chartered corporation and admits opposer's allegation that applicant seeks to register the GIRLSPORTS BRAND mark for goods identified in the involved application. Otherwise, applicant expressly or effectively denies the allegations of the notice of opposition. Applicant has not asserted any affirmative defenses.

The Record

The record in this case is substantial. Each party, for its case in chief, has taken and submitted the testimony of five witnesses. In addition, opposer took and submitted the testimony of a rebuttal witness. There are more than 100 exhibits introduced by the testimony of opposer's six witnesses. There are nearly 100 exhibits introduced by the testimony of four of applicant's five witnesses.[3]

[3] Kathleen Abbott was one of applicant's witnesses. When the transcript of her testimony was filed under cover of the notice of filing required by 37 C.F.R. §2.125(c), the words "with exhibits" in such notice were crossed out and initialed. The initials appear to be those of the individual who signed the certificates of mailing and service. The Board contacted applicant's counsel by phone to confirm the accuracy of the notice of filing and that no exhibits had been filed, leaving a message on a voice messaging system. Many weeks later, applicant's counsel submitted a "[c]opy of certified transcript of the testimony deposition of Kathleen Abbott, with exhibits." The exhibits, however, are not copies of items discussed in the Abbott testimony and appear to be copies of the exhibits to the testimony of opposer's rebuttal witness. While the question of whether applicant intended to submit exhibits for the Abbott deposition remains unresolved, despite the Board's invitation to applicant to settle it, it is clear from our review of the Abbott deposition that the identified exhibits, even if they had been submitted, would not affect our decision. This case essentially

Objections to Evidence

Throughout the taking of testimony, opposer was prolific with its objections. One or more "ongoing" or "continuing" objections were interposed at the beginning of the deposition of each of applicant's witnesses. Typically, these were based on inadequate or improper notice, although one asserted lack of relevance.[4]

Opposer then renewed many of its objections in its brief, so many, in fact, that the brief includes approximately 20 pages of objections prefacing six pages of asserted facts and six pages of argument. Fortunately, we do not need to compare each of the objections in the brief with the many pages of testimony from applicant's witnesses, to determine which objections opposer properly raised and maintained, for few, if any of them, require resolution.

As we will discuss, infra, opposer's claim under Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d), largely turns on the question of priority. Thus, a major part of our analysis will focus on opposer's activities prior to the filing date of applicant's application, and any testimony or evidence from applicant that is probative of applicant's

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turns on the issue of priority and the Abbott testimony is largely irrelevant to disposition of that issue.

[4] Testimony deposition of Rosalinda Vizina. Despite its view of the testimony of this witness as irrelevant, it appears that opposer's rebuttal witness, Pamela G. Saltenberger, was called primarily to rebut the testimony of Ms. Vizina.

pre-filing activities. Accordingly, we have no need to undertake what would be a largely academic exercise, i.e., ruling on each of opposer's many objections to testimony from applicant's witnesses that deals with applicant's activities subsequent to the filing of its application.

There are two broader objections opposer interposed, not in its main brief, but in its reply brief. First, opposer complains that applicant violated applicable rules by taking two testimony depositions on the same day, but in different locations, specifically, in different states. Second, opposer asserts that the transcript of the deposition of one of these two witnesses [Dorothee Hutchinson] was never filed with the Board or served on opposer.

For applicant's failure to file a testimony deposition, opposer requests that we should "not further hear or consider the Applicant herein." We decline this request. Trademark Rule 2.125(a), 37 C.F.R. §2.125(a), provides that a party's remedy when its adversary fails to file a deposition is to request a continuance and, by clear implication, a ruling from the Board that the deposition be filed. If the deposing party then fails to file and serve the transcript after having been ordered to do so, the rule provides that the deposition may be stricken, or judgment may be entered against the refusing party, or other

appropriate action may be taken. Accord, 37 C.F.R. §2.123(h), which provides that the Board may exercise its discretion to not further hear or consider the contestant who *refuses* to file. Opposer has not established that applicant refused to file the deposition transcript. It did not move for a continuance when the transcript was not filed, nor in any other way bring the matter to the Board's attention. Moreover, by failing to raise the matter in its main brief, and bringing it up only in its reply brief when applicant could no longer respond to the argument, opposer has essentially waived its right to seek redress for applicant's failure.[5] To be sure, a party may not merely disregard the rule that requires filing of testimony deposition transcripts, whenever it decides the testimony would not aid the party in any way. Nonetheless, in this case, the Board was not made aware of the violation at an earlier point in the proceeding, when something might have been done, and because we are sustaining the opposition, there is nothing more to be done.[6]

As to applicant's taking of two depositions on the same day, opposer asserts that we should give no consideration to

[5] We also note that, to the extent opposer considered the testimony, although taken by applicant, crucial to the presentation of opposer's case, opposer was free to seek a copy from the court reporter and file a transcript with the Board, with an appropriate request that it be considered. 37 C.F.R. §2.123(h).

[6] Traditionally, the Board has not made awards of costs.

the testimony of either of the two witnesses, or to the exhibits introduced by their testimony. The request is moot, of course, in regard to the witness [Dorothee Hutchinson] whose testimony transcript and exhibits have not been filed. We decline opposer's request that we refuse to consider the testimony and exhibits of the other witness [Kathryn Glaeser] whose testimony was taken on the same day.

Under Trademark Rule 2.123(e)(3), 37 C.F.R. §2.123(e)(3), when objection is made to the taking of a deposition on "improper or inadequate" notice, the objecting party must move to strike the testimony promptly after the testimony is completed. We are not aware of opposer having made such a motion and opposer does not claim that it did. Moreover, even if it would have been proper practice to state the objection at the commencement of the deposition, which opposer did, and to then reiterate the objection during briefing, opposer failed to raise the issue in its main brief. Raising the objection for the first time in its reply brief was inadequate. Finally, we note that an associate of opposer's lead counsel, it appears, did attend the Hutchinson deposition (deposition of Kathleen Abbott, p. 86), so the taking of two depositions on one day in different locations did not prejudice opposer. We deny opposer's request that we not consider the Glaeser testimony and exhibits.

While applicant did assert numerous objections during the taking of testimony from opposer's witnesses, applicant did not maintain these objections in its brief. Accordingly, they have been waived. See authorities collected in TBMP Section 707.03(c) note 289 (2d ed. June 2003). Applicant does, however, make two general objections in its brief.

First, applicant essentially objects to evidence regarding opposer's GIRLSPORTS activities and merchandise that occurred or was produced after the filing date of applicant's involved application, as irrelevant or immaterial. Broadly speaking, applicant is correct insofar as our consideration of the question of priority is concerned, but post-filing date evidence is relevant to likelihood of confusion issues, such as relatedness of the goods and/or services, channels of trade, and classes of consumers. We have considered opposer's evidence, as appropriate, in regard to the issues before us. Second, applicant asserts that "self-serving" evidence from opposer that is contradicted by "documentary" evidence should be disregarded as unreliable. We take this as an exhortation that testimony contradicted by documents should be given little weight. This is not a true objection and is simply a request that we analyze the record in the way we normally

would, and give evidence only the probative value to which circumstances indicate it is entitled.

Findings of Fact

We make the following findings of fact based on the record, primarily focusing on facts that are relevant to the question of priority, which is the critical issue in this case:

Opposer has a staff of executives and employees in New York that provide direction and support to more than 300 Girl Scout councils throughout the United States. Each council represents numerous troops and typically covers a large multi-county area or, in some cases, an entire state. Each troop is composed of numerous individual scouts of varying ages and adult volunteers. Depositions of Kathleen Duncan, pp. 7-8; Dianne Campbell, pp. 7-8; Kathleen Houston, pp. 7-8; Denise Scribner, pp. 5-7; and Pamela Saltenberger, pp. 6-8.

Though precise dates and times have not been established for particular activities, opposer was actively engaged in creating a new initiative for Girl Scouts during the mid-1990s, focusing on sports and fitness. Deposition of Sharon Hussey, pp. 6-13 and exh. 3.

In 1995 and 1996, the initiative was generally known as "Sports + Girls = A Winning Team." Hussey, pp. 12-14, 16, exhs. 3 and 4.

From 1995 through 1997, opposer sought to collaborate with various sports and fitness organizations that could support the goals of the initiative and serve as resources to Girl Scout Councils. Hussey, p. 10, exhs. 3 and 5.

In early 1997, the name of the initiative was changed to GIRLSPORTS and a logo including the term was created. Duncan, pp. 12-15; Hussey, pp. 12-13 and exh. 3.

In the spring of 1997, opposer began disseminating information on the GIRLSPORTS initiative to Girl Scout Councils throughout the United States, soliciting both applications from older Girl Scouts to participate in a national event (referred to by opposer and its councils as a "wider opportunity" event) and applications from councils wanting to hold a Sports Day event in August, September or October 1997. Hussey, pp. 15-18, 20 and exh. 4.

Employees of opposer met with Executive Directors of Girl Scout Councils from across the United States in late June 1997 and presented information on all the components of the GIRLSPORTS initiative. Hussey, pp. 18-19 and exh. 5; Duncan, pp. 14-15.

Opposer's national office distributed to its councils a Girl Scouts Sports Project Manual (copyright 1997) bearing the GIRLSPORTS logo on its cover and including an introductory section entitled "What is the GirlSports Project?" Hussey, pp. 61-62 and exh. 26.

The GIRLSPORTS wider opportunity event was held over approximately a week in late July and early August 1997 at Converse College in Spartanburg, South Carolina. Approximately 200 girls representing over 100 councils from throughout the United States attended the event. Hussey, pp. 21-24 and exhs. 6-7; Duncan, pp. 15-17.

Attendees at the 1997 wider opportunity event paid registration fees and received, inter alia, GIRLSPORTS emblazoned shirts, patches, water bottles and bags. Duncan, p. 16; Campbell, pp. 24-25.

More than 100 councils throughout the United States held "Sports Day" programs from August 1997 through October 1997. These were planned by the individual councils and had varying sports or fitness subjects as their focus. Councils received a $500 grant from GSUSA and a $500 credit for purchasing items from NES. Hussey, pp. 16-18 and exhs. 3-4, 9, 14-15.

Typically, grants and credits were used, inter alia, to purchase GIRLSPORTS t-shirts, water bottles and patches for event participants. Saltenberger, pp. 26-27.

Opposer produced a GIRLSPORTS banner that it expected councils to use at their events, but councils were free to, and did, call their events by a wide variety of specific names. Hussey, pp. 17-18, 138 and exh. 15; Scribner p. 13.

Opposer sold and/or distributed over 40,000 GIRLSPORTS shirts, water bottles and patches in 1997. Duncan exh. 7.[7]

A Sacramento, California area Girl Scout council held a Sports Day program October 25, 1997, at which each participant paid a registration fee and received a GIRLSPORTS t-shirt, water bottle, bag and patch. Saltenberger pp. 11, 16 and exhs. 1 and 4.

Two Girl Scout councils covering counties in Washington state and Oregon sponsored a Passport to Health and Fitness event in the Tacoma Dome on May 30, 1998, as a GIRLSPORTS Sports Day program. More than 2100 girls and adults registered for the event, and nearly 1400 girls actually participated. Participants and volunteers staffing the event received a t-shirt bearing the GIRLSPORTS logo and the words "Passport to Health and Fitness Saturday, May 30, 1998 Tacoma Dome." Houston, pp. 7, 9-18 and exhs. 2, 4-8.

A Bakersfield, California area Girl Scout council had three of its girls attend the first GIRLSPORTS wider opportunity event and subsequently held numerous sports clinics, each identified as a GIRLSPORTS clinic and utilizing GIRLSPORTS signage, during its September 1997 to September 1998 membership year. One of these was a

[7] The spreadsheet produced during discovery as opposer's document number GS 0002923 was marked as confidential. However, when it was submitted as an exhibit to the Duncan deposition it was not sealed and opposer has quoted figures from the exhibit in its brief.

volleyball clinic at Taft College in April 1998, with participants receiving t-shirts bearing the words GirlSports Volleyball and displaying a stick figure playing volleyball. Campbell, pp. 11-24 and exhs. 21-22 and 27-29.

A Wichita, Kansas area Girl Scout council had two girls attend the first GIRLSPORTS wider opportunity event in 1997 and began promoting its summer 1998 sports programs in its early 1998 "Passport" newsletter. Scribner, pp. 10-12, 16-18 and exh. 44.

Wichita area council events were held at least as early as June 9, 11 and 13, 1998. The council produced t-shirts and hats with the GIRLSPORTS logo, for their 1998 events. These also bear the words "Wichita Area Girl Scouts." These were offered for sale between March and August of 1998. Scribner, pp. 13-14, 22-24 and exhs. 44, 46, 47-49, 51.

The initial phase of the GSUSA GIRLSPORTS sports initiative ran through later 1997 and 1998. A second phase involved the GIRLSPORTS 2000 program, which involved a sort of run-up to January 1, 2000. Hussey dep. generally.

GIRLSPORTS 2000 events were held by Girl Scout troops throughout the country virtually every day in 1999, as the goal of the second phase was to try and have a sports event somewhere in the country every day of the year. Hussey dep. generally and exhs. 25 and 35.

GSUSA held wider opportunity events each year from 1997 until at least the year 2000. Hussey, pp. 28-32 and exhs. 10-13.

GSUSA received grants from foundations or campaigns to support GIRLSPORTS programs in 1997, 1999, 2001 and 2002; has had an operating budget for GIRLSPORTS programs each year from 1997 through 2002; and has made grants to councils from those budgets each year from 1997 through 2002. Hussey, p. 32 and exh. 14.

Kathryn Glaeser developed the concept for applicant's products in October 1997, and subsequently formed a partnership with Tamara Spears. Glaeser deposition, pp. 10 and 131; involved application filed by partnership.

Applicant placed its first orders for t-shirts bearing the GIRLSPORTS BRAND mark on March 24, 1998. Ten shirts were ordered. Applicant sold some shirts to friends of Ms. Glaeser and/or Ms. Spears in the spring of 1998. The quantity and precise time frame are not clear. Glaeser, p. 32 and exh. 3, p. 213-17.

Applicant sponsored and/or outfitted a softball team in 1998. The particular clothing that may have been provided and time frame for providing it are unclear. Glaeser, p. 217-18.

Applicant obtained a Business Operations Tax Certificate from the city of Sacramento June 23, 1998, and

registered the domain name girlsports.net six days later. Glaeser pp. 33-34 and exhs. 4-5.

Throughout 1998, Kathryn Glaeser continued to develop graphic elements for applicant's apparel items, for catalogues, and for a website. Glaeser, pp. 132-33.

Applicant's first order was generated from its website and was received November 17, 1998. Glaeser, pp. 48-49 and exh. 13.

Applicant's first ad in a local publication was placed November 25, 1998, and its first ad in a national publication was placed for a February 1999 publication date. Glaeser, pp. 41-44 an exhs. 9 and 10.

Applicant mailed out 7500 postcard advertisements to individuals selected from two mailing lists applicant had purchased (one local and one national), "the end of '98." Glaeser, p. 45 and exh. 11.

Applicant's sales for 1998 were $800. Kathleen Abbott deposition, pp. 109-10.

Decision

Opposer does not have a registration for either the term GIRLSPORTS or its GIRLSPORTS logo. A party opposing registration of another's mark on the basis of likelihood of confusion with its own unregistered mark must establish that the unregistered mark is distinctive of its goods or services either inherently or through the acquisition of

secondary meaning. See Towers v. Advent Software, Inc., 913 F.2d 942, 945, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990).

Applicant, in its brief, does not specifically argue that the term GIRLSPORTS, per se, is descriptive.[8] However, applicant acknowledges the possibility in a footnote [Brief p. 33, n. 2] in which it suggests that this case involves marks that are not inherently distinctive and opposer, to prevail, must prove that its mark has acquired distinctiveness prior to the filing date of applicant's application.

Applicant also argues, in essence, that its GIRLSPORTS BRAND is a mark because those words are used in a consistent style on all of applicant's apparel, advertising and marketing materials; and the "TM" symbol is always used "to denote the trademark intention and status of the mark." Brief, p. 33. In contrast, applicant contends, opposer's method of display of GIRLSPORTS has been inconsistent, insofar as it is sometimes used alone, sometimes as part of a logo, sometimes used by Girl Scout councils or troops in conjunction with other words, and in various fonts or forms

[8] We note that applicant's involved application seeks registration of GIRLSPORTS BRAND on the principal register, without a claim of acquired distinctiveness. The mark published for opposition with a disclaimer only of the term "BRAND" and applicant does not seek registration on the theory that it is only the stylized form of lettering of its mark that renders it registrable, notwithstanding applicant's arguments that the stylization of its mark is an important element thereof.

of stylization. Applicant concludes, therefore, that opposer's use is "merely of words and not as a mark." Id.

Although applicant correctly notes that opposer has used GIRLSPORTS in various type styles and with or without a logo, we find that all such uses are as a mark. There is no requirement that a term be used in only a single type font for it to be a mark. Similarly, a mark owner may obtain rights in a word mark even if the word is also used as part of a logo. We need not reach the question of whether opposer's GIRLSPORTS mark is inherently distinctive, or whether applicant is estopped from attacking opposer's mark on this basis because applicant has sought registration of GIRLSPORTS BRAND as an inherently distinctive mark, for the record clearly establishes that opposer's GIRLSPORTS mark had, at the very least, acquired distinctiveness prior to any use made by applicant of its mark.

Opposer's program was launched with great fanfare among the nation's more than 300 Girl Scout councils, with numerous weekly council mailings from GSUSA to its councils discussing the program throughout the fall of 1997 and spring of 1998. See exhibits 7, 8, 9, 19, 20, 21 and 22 to the Hussey testimony deposition. See also, deposition of Michelle McCormick, executive director of the Girl Scouts council for Santa Clara (California) County, who testified on direct examination by applicant that she first became

aware of the GSUSA initiative in 1997 and who testified on cross-examination "that GirlSports is a very strong national initiative and that you have to be kind of asleep at the wheel to not know that GirlSports was from GSUSA and has lots of great program elements." McCormick dep. pp. 13, 23. See also, the deposition of Lynn Cameron, who testified on direct examination by applicant about how she became aware of the first (1997) GIRLSPORTS wider opportunity event: "Q: And how did you come to know about that? A: Well, because it was the first one. And it was – well, what should I say – made into a big deal."

In turn, councils promoted the program to Girl Scout members, of all ages, and participation therein through their own newsletters and flyers. See, e.g., Campbell deposition exhibits 27 and 28, Houston deposition exhibits 2, 3, 4 and 7, and Saltenberger deposition exhibits 1-5. Councils promoted their GIRLSPORTS events to the media. See deposition of Kathleen Houston, pp. 15-16 and exhibit 5; and deposition of Denise Scribner, pp. 13-14.

On the record in this case, we have no doubt that at least among GSUSA's councils, Girl Scout leaders, and even large numbers of Girl Scouts, the term GIRLSPORTS and the GIRLSPORTS logo quickly became identified with opposer and its programs. Accordingly, even if we were to agree with applicant's theory that varying methods of use or display of

the term GIRLSPORTS by opposer and its councils constituted use of a descriptive term, we would find that opposer's national roll-out of the program in late 1997 and early 1998 imbued the term with distinctiveness as a trademark for sports and fitness events prior to the filing date of applicant's application.

We now turn our attention to opposer's use of GIRLSPORTS and the GIRLSPORTS logo on collateral items that were given away at its 1997 national wider opportunity event, and sold to councils (albeit with the councils typically paying for the merchandise with grant money received from opposer) for distribution or resale at council-level events.[9] Applicant makes much of the fact that GIRLSPORTS is an initiative or program of opposer and that the GIRLSPORTS-branded shirts, bags, water bottles and the like appear intended to simply serve as collateral items for the program, and do not represent an attempt to establish a brand identity for a continuing line of products by opposer that have vitality apart from the GIRLSPORTS program. Nonetheless, the Board has held

> that the mere fact that a collateral product serves the purpose of promoting a party's primary goods or services does not necessarily mean that the collateral product is not a good in trade,

[9] The record is clear that opposer has at least on occasion offered GIRLSPORTS-branded merchandise for sale to councils, council shops, scouts and even outside retailers who sell Girl Scouts authorized products. However, there is no evidence that outside retailers actually purchased such items for resale.

> where it is readily recognizable as a product of its type (as would be the case with T-shirts, for example), and is sold or transported in commerce. See, for example: In re Snap-On Tools Corp., 159 USPQ 254 (TTAB 1968) [ball point pens which are used to promote applicant's tools, but which possess utilitarian function and purpose, and have been sold to applicant's franchised dealers and transported in commerce under mark, constitute goods in trade], and In re United Merchants & Manufacturers, Inc., 154 USPQ 625 (TTAB 1967) [calendar which is used as advertising device to promote applicant's plastic film, but which possesses, in and of itself, a utilitarian function and purpose, and has been regularly distributed in commerce for several years, constitutes goods in trade].

Paramount Pictures Corp. v. White, 31 USPQ2d 1768, 1773 (TTAB 1994).

Further, we note that use of trademarks on collateral products has become quite common. See Turner Entertainment Co. v. Nelson, 38 USPQ2d 1943 (TTAB 1996) and authorities discussed therein. Accordingly, we have no doubt that GIRLSPORTS and the GIRLSPORTS logo are distinctive indicators of opposer as the source of t-shirts, hats, water bottles and the other items that have been sold or distributed in conjunction with opposer's GIRLSPORTS events. Further, based on opposer's sale or distribution of more than 40 thousand shirts and more than 40 thousand water bottles in 1997 alone, we conclude that opposer had attained trademark rights in its GIRLSPORTS marks for these goods prior to the filing date of applicant's application.

We acknowledge that applicant's evidence at trial includes testimony that there were some limited sales of GIRLSPORTS BRAND shirts to friends of one or both of applicant's founding partners, but we do not find this testimony very persuasive. It was presented for the first time in the redirect testimony of Kathryn Glaeser and appears more an afterthought than a principal element of applicant's case. Moreover, the testimony is vague as to when such sales might have occurred, with no documentary support or even the name of an individual purchaser. Likewise, we do not find very persuasive the Glaeser testimony that GIRLSPORTS BRAND shirts may have been provided to friends who were softball players and/or that applicant may have outfitted a softball team in a sponsorship arrangement. Again, the testimony was presented for the first time on redirect, and it is vague and unsupported by documentary evidence – indeed, the witness did not even specify the name of the team. In short, we find that the earliest date on which applicant can rely for purposes of priority is the filing date of its application.

We hold for opposer on the issue of priority[10] and now turn our attention to the question of likelihood of confusion.

[10] We note that the record is clear not only that opposer is the prior user of GIRLSPORTS, but that its use since it first adopted the mark has been continuing and has not been abandoned.

We analyze the issue of likelihood of confusion using the factors that were articulated in the case of In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). See also Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

"The likelihood of confusion analysis considers all *DuPont* factors for which there is evidence of record but 'may focus ... on dispositive factors.'" Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002) (citations omitted).

In many cases, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods and services. See, e.g., Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks"). The case at hand is such a case.

The similarity or dissimilarity of the marks is assessed by comparing the marks as to appearance, sound, connotation and commercial impression. Herbko International Inc. v. Kappa Books Inc., 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002). Moreover, it is well-settled that marks, when compared, must be considered in their

entireties, not simply to determine what points they have in common or in which they may differ. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983). Nonetheless, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Opposer's GIRLSPORTS logo mark and applicant's GIRLSPORTS BRAND mark look different, insofar as they utilize different fonts, and opposer's mark includes a stylized stick figure while applicant's mark includes the term BRAND. The term GIRLSPORTS, however, dominates each mark, both visually and in terms of how they would be articulated. On the latter point, we doubt that many prospective consumers of applicant's goods will be careful to articulate the visually tiny word BRAND when calling for applicant's products, especially since the record clearly shows that applicant has used the term GIRLSPORTS without the term BRAND, thereby helping to condition its customers to focus on the term GIRLSPORTS. In regard to the look of the marks, we return to the fact that opposer does not use only its GIRLSPORTS logo but also uses the term GIRLSPORTS alone and in regular or standard forms of text. Thus, Girl

Scouts, although they may be readily familiar with the GIRLSPORTS logo, will also be familiar with use by opposer of the term GIRLSPORTS alone in varying typefaces. Many likely would conclude, when seeing applicant's mark, that this is simply a new or different form of stylization of the opposer's GIRLSPORTS marks.

Finally, apart from the look and articulation of the involved marks, we conclude that they create similar, if not identical, overall commercial impressions. Applicant has argued that its products have an edgier feel or attitude, but much of the support for applicant's argument stems not from a comparison of the marks but from reference to the other design elements and trade dress that applicant uses for its apparel, e.g., a softball player's bat is shown in one design separating the head of a doll from its body and the slogan "I never played with dolls… I played with this." Our comparison of applicant's mark with those of opposer, however, focuses on the mark as set forth in the application, for applicant may change its shirt designs and slogans at any time. In contemplating the font in which applicant displays the term GIRLSPORTS, we discern nothing particularly "edgy" or full of "attitude." Rather, the font is looping and somewhat lyrical.

We conclude that the marks are virtually identical in the way that they would be articulated, in their

connotations and in their overall commercial impressions. The visual differences would not be viewed as significant and would not provide a means for prospective consumers to readily differentiate the marks.

Turning now to consider the nature of the involved goods and services, we note that opposer's sports programs are precisely the type of activity for which a participant might want to wear a piece of applicant's athletic apparel. Thus, opposer's services provided under its GIRLSPORTS marks and applicant's apparel items are complementary. In addition, opposer's collateral merchandising items are identical (t-shirts and caps or hats) or closely related to applicant's products.

In terms of channels of trade and classes of consumers, we note that applicant's identification of goods is not restricted in any way. Accordingly, we must consider that applicant's goods can be sold in all customary channels of trade and to all possible consumers for "clothing, namely T-shirts, shorts, sweatshirts, sweatpants and caps." Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the

particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed").

Because opposer relies on its common law rights, we must look at the specific channels through which it sells its clothing and collateral goods. These have been limited to Girl Scouts councils, council stores and direct to Girl Scouts members (e.g., through catalogs). These channels of trade are different from applicant's actual and potential channels[11], since we cannot assume that these Girl Scouts outlets are a normal channel of trade for applicant's identified goods. However, because the record shows that opposer distributes merchandise through retailers (Duncan, pp. 8-9), consumers who encounter applicant's goods in retail stores are likely to assume that these items emanate from or are sponsored by opposer.

In regard to classes of consumers, we discount applicant's argument that its products are promoted primarily to older girls and adult females, while opposer's collateral products are asserted by applicant to be marketed only to younger girl scouts. In fact, we note that the ages of the scouts who attend opposer's national "wider

[11] The record shows that 80 percent of applicant's sales are at trade shows, while 20 percent are through its catalog and website (Abbott, p. 106). Applicant, however, has attempted to arrange distribution of its products by retailers (Glaeser, pp. 66-68).

opportunity" events place the attendees squarely within applicant's professed market. Moreover, applicant's testimony is that it has actually sold some of its products to members of the Girl Scouts, Abbott, p. 52, and its catalog shows that it sells youth size caps and shirts, the latter in as small a size as 6-8, Glaeser exh. 58[12].

In short, based on the record and because of applicant's unrestricted identification, we find a clear overlap in classes of consumers.

Applicant's witnesses Glaeser and Abbott both have testified that no customer of applicant's has ever made an inquiry about whether applicant is affiliated with opposer's GIRLSPORTS program, and they are not aware of any instances of actual confusion. We do not find this testimony particularly probative that there is no likelihood of confusion. Evidence of actual confusion is difficult to obtain and its absence from the record in a case does not mean there is no likelihood of confusion. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983).

In conclusion, we find the evidence of record clearly supports a finding that there is a likelihood of confusion. We therefore sustain the opposition based on opposer's

[12] We also note that the items on this page of applicant's catalog are dislayed with the slogan CLUB GIRLSPORTS™, and the youth caps and shirts bear the term GIRLSPORTS, not GIRLSPORTS BRAND.

demonstrated prior use of the unregistered marks GIRLSPORTS and the GIRLSPORTS logo for its health and fitness initiative for Girl Scouts and the collateral products produced, sold and distributed in conjunction therewith. Having sustained the opposition on this basis, we do not reach the claim asserted by opposer under 36 U.S.C. §80305.[13]

Decision: The opposition is sustained and registration to applicant is refused.

[13] Opposer points to only one case purportedly finding in favor of opposer based on the provision of Title 36. A careful reading of that case, however, shows that the court held for opposer on a traditional trademark analysis.